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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,325	12/14/2001	Bradley Taylor	MPT-003	4911
22888	7590	06/12/2008		
BEVER HOFFMAN & HARMS, LLP			EXAMINER	
2099 Gateway Place			COULTER, KENNETH R	
Suite 320				
San Jose, CA 95110			ART UNIT	PAPER NUMBER
			2141	
			MAIL DATE	DELIVERY MODE
			06/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/022,325

Applicant(s)

TAYLOR, BRADLEY

Examiner

Kenneth R. Coulter

Art Unit

2141

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/8/08 (pre-appeal conf. decision).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 20 and 25 – 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 1 and 25 are directed to methods that can be interpreted as programs.

Independent claim 11 is directed to a computer program product that might be solely implemented in a program.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

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Hardware can be added to these independent claims (e.g. method implemented in hardware; computer program product implemented in hardware) in order to overcome the 35 USC 101 rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 6, 11 – 16 and 25 – 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirani et al. (U.S. Pat. Pub. No. 2002/0016818) (System and Methodology for Optimizing Delivery of Email Attachments for Disparate Devices).

2.1 Regarding claim 1, Kirani discloses a method of providing a fast path message transfer agent, the method comprising:

receiving bytes of a message over a network connection (Abstract; Figs. 1, 3, 4; paragraph 64);

determining whether the number of bytes of the message exceeds a predetermined threshold of bytes set for a message, wherein if not, then writing the message only to a memory, and wherein if so, then writing the message to the memory and a non-volatile storage (Abstract “**compares the size of attached images to the capabilities of the type of the recipient client device**, and preempts delivery of the original format of those attachments ... **the original attachments are removed from the messages** and do not accompany the e-mail delivery. **Any detached attachment is saved in a network media-sharing repository** ...”; Fig. 1, items 115, 116; Figs. 3, 4; paragraph 52 “flash memory” “hard disk”; paragraph 64).

2.2 Per claim 2, Kirani teaches the method of claim 1, wherein writing the message to the memory and the non-volatile storage includes:

writing a portion of the bytes up to the predetermined threshold to the memory; and storing a remainder of the bytes onto the non-volatile storage (Abstract; Fig. 1, items 115, 116; paragraphs 52, 64).

2.3 Regarding claim 3, Kirani discloses the method of claim 2, wherein writing the message to the memory and the non-volatile storage further includes:

determining whether all bytes of the message have been received (Abstract; paragraphs 8, 52, 64, 112);

wherein if not, then receiving additional bytes of the message over the network connection (Abstract; paragraphs 52, 64); and

writing the additional bytes onto the non-volatile storage (Abstract; Fig. 1; paragraphs 52, 64); and

wherein if so, then proceeding to re-route the message (Abstract; Fig. 1; paragraphs 52, 64).

2.4 Per claim 4, Kirani teaches the method of claim 3, wherein if the number of bytes is less than the predetermined threshold and all bytes of the message have been received, then proceeding to re-route the message (Abstract "**Any detached attachment is saved in a network media-sharing repository ...**"; Fig. 1; paragraphs 52, 64).

2.5 Regarding claim 5, Kirani discloses the method of claim 4, further including:
accessing the message (Abstract; paragraphs 8, 52, 64, 112);
sending the message to each destination (Abstract; paragraphs 8, 52, 64, 112);
and
determining whether the message was received successfully by each destination (Abstract; paragraphs 8, 52, 64, 112).

2.6 Per claim 6, Kirani teaches the method of claim 5, wherein if the message was received successfully by each destination, then
indicating a successful receipt of the message (Abstract; paragraphs 8, 52, 64, 112).

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However, Kirani does not explicitly disclose **deleting** the message from the memory and the non-volatile storage.

Such a scenario is inherent in clear the memory for later use with large messages.

2.7 Regarding claims 11 – 16 and 25 – 27, the rejection of claims 1 – 6 under 35 USC 102(e) (paragraphs 2.1 – 2.6 above) applies fully.

3. Claims 25 – 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho (U.S. Pat. No. 5,978,452) (Voice Data Recording and Transmitting Method and Apparatus for Facsimile Linked to Personal Computer).

3.1 Regarding claim 25, Cho discloses a method of providing a fast path MTA, the method comprising:

receiving a network connection from an email server (Abstract; Fig. 1; col. 3, lines 58 – 64);

receiving bytes of a message over the network connection (Abstract; Fig. 1; col. 3, lines 58 – 64); and

determining whether a number of bytes of the message exceeds a predetermined threshold of bytes set for a message, wherein if not, then writing the message only to a memory, and wherein if so, then writing the message only to non-volatile storage (lengthy “voice message” scenario considered; col. 4, lines 35 – 49

"**sending the overflow of voice messages from the voice message memory 130 to an auxiliary memory** such as a **hard disk** of the PC 138 for storage.").

3.2 Per claim 26, Cho teaches the method of claim 25, further including if all bytes of the message have not been received, then receiving additional bytes (Abstract; Fig. 1; col. 3, lines 58 – 64; col. 4, lines 35 – 49).

3.3 Regarding claim 27, Cho discloses the method of claim 26, further including if a total number of bytes exceeds a predetermined threshold, then storing the total number of bytes in a non-volatile storage device (col. 4, lines 35 – 49).

However, Cho does not explicitly disclose **deleting** the message from the memory and the non-volatile storage.

Such a scenario is inherent in clear the memory for later use with large messages.

Response to Arguments

Applicant's arguments with respect to claims 1 – 20 and 25 – 27 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2141

krc